REMARKS

Reconsideration of the Application respectfully is requested. A Petition for Extension of Time (one month) is being flied concurrently herewith. For the reasons indicated hereafter, the Application is urged to be in condition for allowance.

As requested by the Examiner in the Official Action, additional botanical information concerning the 'Meichibon' variety has been diligently sought and is provided in the Substitute Specification to the extent available. It respectfully is submitted that those skilled in plant science will have no difficulty in identifying plants of the 'Meichibon' variety in view of Applicant's detailed Specification and photograph. The withdrawal of the rejection under 35 U.S.C. §112 is urged to be in order and is respectfully requested.

It respectfully is pointed out that the request for information under 37 C.F.R. § 1.105 with respect to the public use and availability of the 'Meichibon' plant outside of the United States bears no relationship to the statutory bases for the denial of patent protection pursuant to Title 35 of the United States Code, and accordingly is not justified under the language of 37 C.F.R. § 1.105 since such information is not "reasonably necessary to properly examine or treat the matter." Also, any publications by Applicant that occurred less than one year prior to the August 21, 2001 filing date of the present Application are not relevant under any circumstances.

Additionally, this request with respect to availability of the plant outside the United States constitutes an unannounced substantive departure from prior practices of the United States Patent and Trademark Office as they have existed for over seventy years that if maintained could substantially limit patent rights and thereby have a substantial adverse

impact upon the entire plant industry. Plant public use and availability outside the United States is not statutory prior art. Applicant is entitled to rely upon the long-standing practice of the United States Patent and Trademark Office. Accordingly, the recent action by personnel of the United States Patent and Trademark Office is urged to be inappropriate and should be discontinued.

Nevertheless, in a sincere effort to expedite prosecution Applicant provides on information and belief information that was requested to the extent available. It respectfully is submitted that this information when properly evaluated in accordance with the statutory parameters of 35 U.S.C. § 102 presents no statutory impediment to patentability.

(1) Plants of the 'Meichibon' variety entered quarantine in the United States on August 1, 1995 in the absence of the release of the variety to the public in the United States. Such plants left quarantine in the United States on July 14, 1997 and then commenced testing and evaluation in the United States in the absence of release to the public in the United States.

(2) Plant Breeders Rights Application No. 16177 directed to the 'Meichibon' variety was filed in France on May 11, 1998. A publication of the French Ministry of Agriculture entitled "Protection Des Obtentions Vegetales", No. 5 (1998), at Page 206 makes reference to the filing of French Plant Breeders Rights Application No. 16177 and eight words are used to specify its characteristics. At Page 212 the proposed 'Meichibon' denomination is provided. Copies are attached as Exhibit A. This publication was received at Applicant's office in France on June 22, 1998. This French Breeders

Rights protection was surrendered in favor of European Community protection. Since the French Breeders Rights had been surrendered at the time the present Application was filed in the United States, it was not listed in Applicant's Declaration that was filed with the present Application.

(3) Plant Breeders Rights Application No. 99/0285 was filed in the European Community on February 25, 1999 as indicated in the Declaration that was filed with the present Application. Attached as Exhibit B are copies of pages from the June 15, 1999 issue of the Official Gazette of the Community Plant Variety Office. This was received at Applicant's office in France on June 28, 1999. At Page 19 there is reference to the filing of Plant Breeders Rights Application No. 99/0285 directed to the 'Meichibon' variety. At Page 30 the proposed 'Meichibon' varietal denomination appears.

(4) The August 15, 2000 issue of the Official Gazette of the Community Plant Variety Office, makes reference at Page 49 to the grant of Breeders Rights protection No. 6301 in the European Community. Attached as Exhibit C are copies of pages from this publication. The date that this publication was actually made available to the public is unknown to Applicant.

(5) Plant Breeders Rights Application No. 00-27-1629 was filed in Switzerland on June 20, 2000 as indicated in Applicant's Declaration that was filed in this Application. Nothing is known to have been published with respect to this Swiss Application more than one year prior to the August 21, 2001 filing date of this Plant Patent Application.

(6) Plants of the 'Meichibon' variety are understood to have been first made available to the public for growing non-experimental purposes in France on approximately May 20, 1999. The public use and availability of a claimed invention in a foreign country more than one year before the filing of a Patent Application in the United States is not prior art and cannot be considered to be an impediment to United States Patent protection under the express language of 35 U.S.C. § 102. See, *Gandy et al. v. Main Belting Co. et al.*, 143 U.S. 587, 12 S.Ct. 598 (1892), and *Allied Colloids Inc. v. American Cyanamid*, 64 F.3d 1570 (Fed. Cir. 1995). Also, the availability of a plant variety in a foreign country has never until recently been considered by a United States Patent Examiner to be an impediment to variety protection under the Plant Patent Act (*i.e.*, 35 U.S.C. §§ 161 to 165) during the 70+ years since its enactment in 1930.

(7) Attached as Exhibit D is a copy of a page from a January 2000 catalog of MEILLAND RICHARDIER that was made available to others in France and identifies the 'Meichibon' variety. This is the most legible copy available to the undersigned attorney.

(8) Plants of the 'Meichibon' variety have not been placed on sale or otherwise been made available to the public for growing for non-experimental purposes in the United States more than one year prior to the August 21, 2001 filing date of the present Plant Patent Application.

It respectfully is pointed out that any information contained in Exhibits A through D with respect to the 'Meichibon' variety that was published more than one year before the filing date of the present application in the United States could not enable one skilled in plant science in combination with his or her own knowledge of the particular art to reproduce and to thereby be in possession of the claimed plant when taking into consideration the existing state of the art with respect to plant heredity, etc. Even if the plant were described in detail in these exhibits (which it was not) even the most skilled plant scientist could not go into the greenhouse or field and again create it. The underlying genetics are far too complex to achieve such result. In fact, even Applicant could not today reproduce the creation of the same 'Meichibon' variety through a repetition of the same plant breeding program with full knowledge of every word of the contents of Exhibits A through D in view of the complex expression of genes that have been appropriately aligned in the claimed variety. Each and every offspring of the same breeding program using the same parent plants would be physically and biologically different from each other as indicated at Page 1 of Applicant's Substitute Specification.

The *In re LeGrice* decision of the Court of Customs and Patent Appeals dated May 4, 1962 and reported at 133 USPQ 365 is controlling authority for Examiners of the U.S. Patent and Trademark Office and must be followed during the examination when a comparable factual situation is presented as in the present application. It was there held that in order to be a statutory bar, a printed publication with respect to a new plant variety that is sought to be patented under 35 U.S.C. §§ 161 to 165 must be adequate in its teachings to enable the reader in combination with his or her own scientific knowledge of

the particular art to be in possession of the plant when taking into consideration the existing "store of knowledge in fields of plant heredity and plant eugenics which one skilled in the art will be presumed to possess." The two rose varieties under discussion in the *LeGrice* case were available to the public outside the United States well more than one year before the filing dates of the Plant Patent Applications that matured into United States Plant Patent Nos. 2,209 and 2,210. This is confirmed at Page 2 of the February 12, 1960 *LeGrice* Board of Appeals Decision where it stated:

> The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing date of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. (underlining added)

Such availability of plant material of the claimed varieties abroad was not relevant to the examination in view of the express language utilized by Congress in 35 U.S.C. § 102. Public use and availability of the subject matter of a Patent Application in a foreign country more than one year before the filing date is not an impediment to United States Patent protection. See, the *Gandy et al. v. Main Belting Co., et al.,* Supreme Court decision cited earlier. The Judges at the Court of Customs and Patent Appeals reasonably can be concluded to have considered the underlying facts and the February 12, 1960 decision of the Board of Appeals in detail. Had the availability of plants of the subject *LeGrice* varieties outside the United States been considered to be relevant in its evaluation, it would have been addressed in the written decision. Such issue had been resolved by the United States Supreme Court many years earlier and was not open for discussion. This *In re*

LeGrice decision that was written by the respected patent jurist, Arthur M. Smith, clarified the law with respect to when a printed publication can serve as a statutory bar to plant variety protection and properly has been applied and followed by Examiners of traditional Plant Patents pursuant to 35 U.S.C. §§ 161 to 165 for several decades following its issuance.

The subsequent decision of the Board of Patent Appeals and Interferences in *Ex parte Thomson*, 24 USPQ 2d 1618 (1992) involving a utility Patent Application has not been followed by Examiners of the U.S. Patent and Trademark Office in the past for good reason. It should be recognized to constitute an ill-conceived action by the Patent Office administrative tribunal that is unsound from both technical and legal standpoints. It has never been the law with respect to non-plant inventions when similar enablement issues with respect to a publication arise. 35 U.S.C. § 102 was misapplied in *Thomson*. There is no reason for the law in this area to be different when applied to a plant invention. Further the fact situation in the *Thomson* case cannot reasonably be distinguished from that of the controlling Court authority with respect to traditional Plant Patents - *In re Le Grice*. In both instances, there was public use and availability of plant material outside the United States more than one year before the United States filing dates. Also, the cavalier "someday is here" reasoning expressed in the *Thomson* decision should be recognized to be scientifically inaccurate. From a scientific standpoint there is today no way that even the most skilled plant scientist could reproduce the claimed 'Meichibon' variety from a reading of anything that was published with respect to this variety more than one year prior to the August 21, 2001 filing date of the present application. The mere possibility for one to seek

a plant in a foreign country and to bring such plant to the United States has never been an impediment to variety protection in the United States in the absence of a showing that the variety was on sale or in public use in the United States more than one year before the United States filing date. No statutory anticipation has been or is capable of being established with respect to the 'Meichibon' variety.

The Examiner has cited no authority for the assertion that the availability of an invention outside the United States combined with a non-enabling publication has ever been used to create a statutory bar other than the *Ex parte Thomson* decision. As specified at 35 U.S.C. §161, Plant Patents and Patents for other inventions should be subject to the same statutory provisions "except as otherwise provided." Title 35 provides no exception capable of supporting a different rule for Plant Patents. Examiners of the U.S. Patent and Trademark Office must follow the statutory language of Title 35 of the United States Code.

The issuance of a formal Notice of Allowance is urged to be in order and respectfully is requested. Basic fairness to Applicant requires this outcome. If there is any remaining point that requires clarification prior to the allowance of the Application, the

Examiner is urged to telephone the undersigned attorney so that the matter can be discussed and resolved at a personal interview.

Respectfully submitted,

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